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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,902	03/01/2002	Joseph W. Hundley		3526

7590

04/09/2003

THE TECHNOLOGY LAW OFFICES OF VIRGINIA
P.O. Box 818
Middleburg, VA 20118

EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/086,902		HUNDLEY, JOSEPH W.	
	Examiner		Art Unit	
	Cephia D. Toomer		1714	

-- **Th MAILING DATE of this communication appears on th cover she t with the correspondenc address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30 is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. It should be noted that claims 34-44 have been renumbered as claims 33-43 according to 37 CFR 1.126.

Double Patenting

3. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-19 of copending Application No. 09/757765. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the current application encompass the emulsion of the claims of 09/757765.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3, 4, 5, 7, 10, 11, 13, 14, 16, 17, 20, 21, 22, 23, 24, 26, 27, 28, 29, 31, 32, 35, 36, 39, 41, 42, and 43 are rejected under 35 U.S.C. 112, second paragraph, as

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being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 3 and 23, it is not clear what constitutes "olefinic wax-like materials."

Claim 4 is rejected because there is no antecedent support in claim 1 for proportions of the polyvinyl alcohol.

In claim 5, there is no antecedent support in the previous claims for the proportion of polyvinyl alcohol and the biocide.

In Claims 7 and 31, "The method" should read --A method--.

Claim 10 is rejected because it is not clear if 0.505 is percentage by weight.

Claim 11 is confusing. It is suggested that the claim be rewritten as follows: -- A method as claimed in claim 7 wherein the composition is applied to the material by spraying.--

Claim 13 is rejected because it is not clear to which Federal Air Quality Regulations the method complies.

For clarity, it is suggested that the terms "and including" be deleted and replaced with the terms -- further comprising -- (see claims 14, 16, 17, 22, 26, 29, 35, 36 and 41).

Claim 20 is rejected because the term "high" is a relative term that does not have a comparative value.

Claims 21, 27, 28, 42 and 43 should be amended using conventional claim language; i.e., --comprising -- or -- comprises --.

Claim 24 is rejected because it is not clear if "221" should read -- 22 -- or -- 21 --.

In claim 31, "Steaeric" should read -- stearic --.

In claim 32, there is no antecedent support in claim 30 for "said hydrocarbons."

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Claim 39 is rejected because there is no antecedent support in claim 34 for "the range of the wax."

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by CN 1290729.

CN teaches a composition comprising NaOH, ammonia water, stearic acid, paraffin wax, titanium dioxide and water (see abstract in its entirety).

Accordingly, CN teaching all the material limitations of the claims, anticipates the claims.

8. Claims 21, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by CN 1031363.

CN teaches a composition comprising paraffin wax, Vaseline oil, stearic acid and mineral oil (see abstract in its entirety).

Accordingly, CN teaching all of the material limitations of the claims, anticipates the claims.

9. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by CN 1116650.

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CN teaches a fuel composition comprising stearic acid, paraffin wax, NaOH and water (see abstract in its entirety).

Accordingly, CN teaching all the material limitations of the claim, anticipates the claim.

10. Claims 40 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by DD 54048.

DD teaches a composition comprising 6-15% paraffin wax, 1-3% of 20% solution of NaOH, and 20-50% water (see abstract in its entirety).

11. Claims 1-6, 21, 27, 40, and 42 are rejected under 35 U.S.C. 102(b) as being anticipate by Borenstein (US 5,437,722).

Borenstein teaches an aqueous emulsion comprising paraffinic wax, montan wax and polyvinyl alcohol (see abstract). The montan wax is present in the composition in an amount of about 1 to 200 parts, by weight, per 100 parts of paraffin (see col. 2, lines 12-19). The water makes up from 35 to 80% of the composition. The composition also contains alkali metal or ammonium hydroxides stabilizers (see col. 3, lines 18-20).

The polyvinyl alcohol is at least 90% hydrolyzed polyvinyl acetate and is present in the composition in an amount from 1 to 50 parts, by weight, per 100 parts paraffin (see col. 3, lines 4-9; col. 2, lines 29-31).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 27, 33-36 and 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over CN 1290729.

CN has been discussed above. CN fails to teach a method of assisting complete combustion of a material. However, it would be reasonable to expect that CN would be successful in obtaining this objective since CN teaches the same composition as that of the present claims and he teaches the same step as recited in the claims, i.e., applying the composition to the material.

CN fails to specifically teach that the composition contains 30% water or 2% stearic acid. However, it would have been obvious to one of ordinary skill in the art to have selected this amount of water because CN teaches that the composition of its invention contains up to 20% water and that the composition contains ammonia water. This teaching suggests that the combination of the water and the ammonia water, wherein the ammonia water contains more water than ammonia, would equate to 30% water in the composition.

With respect to the amount of stearic acid present in the composition, the claimed proportion and the range taught by the prior art are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp.* 227 USPQ 773 (Fed. Cir. 1985).

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14. Claims 40, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over CN 1116650.

CN '650 has been discussed above. CN fails to teach that the composition contains 30% water. However, the claimed range and the prior art range are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp.* 227 USPQ 773 (Fed. Cir. 1985).

15. Claims 7-11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borenstein (US 5,437,722).

Borenstein has been discussed above. Borenstein teaches the limitations of the claims other than the differences that are discussed below.

Borenstein differs from the claims in that he does not specifically teach the claimed method. However, it would be reasonable to expect that the composition of Borenstein would assist complete combustion of the material since Borenstein's method steps and Applicant's method steps are the same, i.e., the composition is applied to the material. Also, no unobviousness is seen in Applicant's mode of applying the composition because it is one of the logical ways of applying the composition to a material and the skilled artisan would have recognized this.

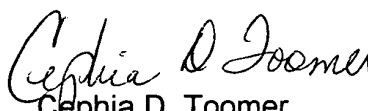
16. Claim 30 is allowable because the prior art fails to teach the claimed composition.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Cephia D. Toomer
Primary Examiner
Art Unit 1714

1008690214
April 7, 2003